

REMARKS/ARGUMENTS

In response to the Restriction Requirement set forth in the Office Action of August 13, 2003, Applicants hereby elect Group II. However, the Restriction Requirement is respectfully traversed.

Firstly, it is noted that the application has already gone through extensive examination, up to and including the filing of an Appeal Brief. Throughout this extensive examination, the entire scope of compound claim 1 has been examined. It is submitted that a Restriction Requirement at this point in time is unnecessary and unjustified. Clearly, the examination of the entire scope of claim 1 does not impose any serious burden upon the Examiner, particularly in light of the extensive examination which has already been performed.

In the Restriction, the compounds of Applicants' claim 1 are divided into four groups, i.e., Group I, Group II, Group XIV and Group XV, depending upon the definitions of groups R^1 , R^2 , R^3 and R^4 . It is argued that these Groups are drawn to structurally dissimilar compounds with different cores and different methods of use. This is incorrect. One need merely look at formula I to see that all of these compounds share a very substantial common core. As a result, the compounds are not significantly structurally dissimilar. Furthermore, Restriction provides no rationale for the assertion that the compounds are dissimilar in regards to their methods of use.

At the bottom of page 4 of the Office Action, it is argued that in the vitamin D art, compounds that have a 19 nor structure in which R^3 and R^4 are H or alkyl and which have a double bond in the side chain "will be different" from the compounds having a 19-methylene group and R^3 and R^4 other than H or alkyl. It is clearly self-evident that individual compounds within a Markush group will be "different". If not, they would be the same compound. Thus, a mere assertion of a structural difference fails to provide any basis for a Restriction requirement. Moreover, the Restriction presents no rationale as to why this self-evident difference is sufficient to justify a Restriction or a lack of unity argument.

Similarly, the Examiner's comments with respect to the definitions of groups Z and Q, that minor changes in structure can be "very significant" does not provide a basis for a Restriction or an assertion of lack of unity. The assertion of "very significant" is a mere conclusion and no discussion is provided as to what is meant by "very significant".

Also, with regards to the method of use claims, i.e., Groups III- VI and XI- second numeral XIII (there are two XIII in the Restriction), it is noted that under PCT Rules 13.1-13.2, Applicants are entitled to have claims in different categories when those categories are a product,

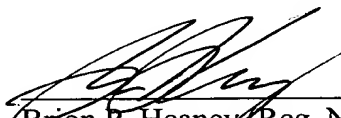
a process adapted for the manufacture of the product, and a use of that product. Therefore, Applicants respectfully submit that Group III should be examined along with the elected invention of Group II.

With regards to claim 19 (Group VII), it is respectfully submitted that this claim, which is drawn to specific compounds, should be examined along with the Group elected, at least to the extent that compounds of claim 19 fall within the subject matter of Group II.

Finally, with regard to Group VIII, it is respectfully submitted that this group, i.e., claim 29, should also be examined with Group II. Claim 29 is merely directed to methods for preparing pharmaceutical compositions and thus encompasses methods of preparing compositions included within the subject matter of Group II. Therefore, Applicants submit that Group VIII should be examined, at least to the extent that it encompasses the manufacture of pharmaceutical compositions containing compounds from within Group II.

As a final note, the submission of Applicants' of additional dependent claims is clearly permissible. Moreover, such dependent claims do not change the scope of the search required for examination.

Respectfully submitted,



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